



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/047,987 | 01/17/2002 | Veronique Ferrari | 05725.1020-00 | 3250 |

7590

12/11/2003

Thomas L. Irving
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

| EXAMINER |
|----------|
|----------|

VENKAT, JYOTHSNA A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1615

DATE MAILED: 12/11/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,987

Applicant(s)

FERRARI, VERONIQUE

Examiner

JYOTHSNA A VENKAT

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65-146 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65-146 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☒ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of specification, declaration, specification, priority, preliminary amendment A and CFR filed on 5/17/02, 6/14/02 and 8/7/02. The preliminary amendment cancelled claims 1-64 and added claims 65-146. Claims 65-146 are pending in the application and the status of the application is as follows;

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 65-146 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 5,998, 570('570); 6,749,173('173); 6,224,851('851); 6,399,080('080) and 6,203,780('780).

The instant application is claiming a structured composition, gel composition, product, and lipstick comprising liquid fatty phase comprising:

- 1. Fluoro oil. The species are claimed as formulae II-XII in claims 90-112.*
- 2. polymer. The species belonging to this polymer is claimed as formula I in claims 85-87.*
- 3. additional oil . Claims 117-125*
- 4. apolar oil of claims 126-127*
- 5. dyestuff*
- 6. additive*

The patent '570 teaches formula I, which is ingredient 2, claimed in cosmetic products. See cols 2-5, see col.16, lines 13-33 for apolar oils. The patent at col.3, lines 44-46 teaches that this polymer can be used in personal care products like lipstick, foundation make up and eye make up which includes mascara claimed in the instant application along with lipstick. See col.17, lines 42-48 for the additives. The patent does not teach ingredients 1 and 3-5. However patent '173 teaches lipstick-using 1 which is formulae II-III along with ingredients 3-6. See col.4, lines 25 et seq for the fluoro oil species and see col.s 5-6 for 3-4 and see col.col.8 for 5-6 and see the examples. The patent '851 teaches fluoro oils of formulae IV-IX in cosmetic products as transfer resistant agents. See col.s 2-4 and see the examples. The patent '080 teaches formula X in cosmetic compositions along with formulae IV, VIII and IX. See col.s 1-2. the formula X corresponds to formula IV of the patent and formulae IV, VIII and IX correspond to formulae I-III respectively. The patent also teaches 3-6. See cols. 4 and see the paragraph bridging cols. 5-6 for dyestuff and see col.7, lines 52-57 for various additives. The patent '780 teaches fluoro oil which is formulae XI and XII along with ingredients 3-6. See col.3, lines 1-37 for oils, see col.7 last paragraph for additives and see col.8, lines 31-52 for the dyestuff.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '570 and combine it with the *fluoro oils* of '6,749,173('173); 6,224,851('851); 6,399,080('080) and 6,203,780('780). expecting beneficial effect to the cosmetic products when applied. The motivation to use the *fluoro oils of the various patents stems from the teaching of these patents that these fluoro oils are transfer resistant agents*. One of ordinary skill in the art would certainly

Art Unit: 1615


be motivated to combine the ingredients with reasonable amount of success, because both the main ingredients 1 and 2 are used individually in the cosmetic products like lipstick and eye make up and the combination of the fluoro oils with the polymer would yield a transfer resistant product with the advantages of having a transparent material . The idea of combining the ingredients flows logically from the art. This is a prima facie case of obviousness.

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


JYOTHSNA A VENKAT
Primary Examiner
Art Unit 1615